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77224	7590	10/28/2009	EXAMINER	
Mary E. Golota Cantor Colburn LLP 201 W. Big Beaver Road Suite 1101 Troy, MI 48084			LIGHTFOOT, ELENA TSOY	
			ART UNIT	PAPER NUMBER
			1792	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Advisory Action

The Request for Reconsideration filed on October 19, 2009 under 37 CFR 1.116 in reply to the final rejection has been entered and considered but is not deemed to place the application in condition for allowance for the reasons of record set forth in the Final Office Action mailed on May 18, 2009.

Response to Arguments

Applicant's arguments filed October 19, 2009 have been fully considered but they are not persuasive.

1. Rejection of claims 1-3, 5-8, 12, 14-20, 22, 24, and 25 under 35 U.S.C. §103(a) as being unpatentable over Mayer (US 5,633,037) and Applicants' admitted state of art (hereinafter AAA), further in view of Hartung et al. (US 5,368,944) and further in view of Duda et al. (US 6,495,201)

(A) Applicants submit that there are several very significant differences between Mayer and the present process. Importantly, Mayer is directed to a conventional refinish that repairs a damaged original finish of an automobile, after having been built and used. Such conventional refinish will herein be referred to as a "post-OEM refinish" that takes place in "conventional refinish workshops." Thus, in contrast to the present invention, **Mayer is directed to a process of post-OEM refinish for the repair of damage such as caused by an automobile accident or "fender bender."** In no case does Mayer refer to overcoating or repairing of a defect in the original finish or to refinish at an automaker's plant. Rather, Mayer refers to refinishing in which a coating material is first applied to the prepared area of "damage," "which damage is mentioned four times in the Abstract of Mayer. Specifically, throughout the patent, Mayer refers to damage but never to a defect with respect to an original finish. It is especially relevant that Mayer's examples disclose, in the original finish, a basecoat based on cellulose acetobutyrate, as compared to various refinish coatings that do not contain any cellulose acetobutyrate. In addition, the refinishing in Mayer is conducted at 60°C, rather than the higher temperatures commonly used at a manufacturer's plant. It is clear that, in Mayer, none of the coating materials from the original finish are used in refinishing. Mayer states, for example, that a "conventional refinish primer surfacer" is applied. Col. 17, lines 29-30. In contrast, the present invention requires applying the extract "to an outer surface of the (original) multicoat paint system." It is clear that, since Mayer is directed to a post-OEM refinish, Mayer necessarily does not teach using any coating materials related to the original basecoat, as required for the clearcoat of step (1) and the aqueous basecoat (3) of claim 1.

The Examiner respectfully disagrees with this argument. First of all, Mayer (US 5,633,037) is of the same patent family as EP 0 521 040 B2 that is described in the Applicants' specification at P5. The specification as originally filed discloses: "European patent EP 0 521 040 B2 discloses a process for producing a multicoat refinish system in the conventional sense, in which a pigment-free, aqueous, film-forming coating composition is first applied in the region of the defect in the OEM finish, followed by an aqueous refinish basecoat material. The coating composition may be a pigment-free extract of the aqueous refinish basecoat material. A clearcoat material is then applied wet on wet to the aqueous basecoat film, after which the films present are cured together. This process constitutes a significant advance in refinish in the conventional sense". In other words, Applicants now argue against their own disclosure!

Second, it seems that Applicants conclusion "**Mayer is directed to a process of post-OEM refinish for the repair of damage such as caused by an automobile accident or "fender bender"**" is based mainly on the use of the term "damage" in Mayer. Applicants seem to think that one of ordinary skill in the art does not use the term "damage" in OEM. This is incorrect. In contrast to Applicants statement, the term "damage" is used in the art not only for used cars for also for OEM production lines too, as evidenced by US 20070116866 to Mich (See P12, last four lines) and US 20080235224 to Rodrigues et al (See P48, lines 4-6). Moreover, Mayer teaches refinishing after the automobile was built; and Mayer teaches nowhere that refinishing is carried out after the automobile was used.

Third, it is held that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Mayer is applied in combination with Hartung et al that teaches that refinishing can be effected shortly after the original finishing on the production line as well as after the automobile has been built (See column 5, lines 62-68). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have carried out refinishing in Mayer shortly after the original finishing on the production line, as taught by Hartung et al.

Forth, it is irrelevant that Mayer's examples disclose, in the original finish, a basecoat based on cellulose acetobutyrate, as compared to various refinish coatings that do not contain any cellulose acetobutyrate, because damage may occur after the original paint is completely

Art Unit: 1792

cured in OEM operation, and thus, refinish may be formulated as repair formula, as evidenced by US 20080235224 to Rodrigues et al (See P48, lines 4-8).

(B) Applicants submit that Hartung does not teach or remotely suggest that Mayer's use of an underlying clearcoat should be used, but not the tapering. Both are necessary in Mayer. Hartung says absolutely nothing about the use of a clearcoat extract and makes no mention or suggestion with respect to the tapering technique of Mayer. There is nothing in Hartung that remotely suggests that one of ordinary skill in the art should use the same basecoat and clearcoat for producing both the original finish and repair finish without using a primer-surfacer or sanding to bare metal. There is nothing in Hartung that remotely suggests using electrostatic spraying for the original basecoat and pneumatic spraying for the refinish basecoat. In fact, there is absolutely no teaching of this in either Mayer or Hartung. The mere assertion that OEM refinish, in general, occurs shortly after OEM original finish, falls far short of any such teachings.

The Examiner respectfully disagrees with this argument. Hartung et al is a *secondary* reference which is relied upon to show that refinishing can be effected shortly after the original finishing on the production line using a fresh coating of basecoat and clearcoat as well as after the automobile has been built (See column 5, lines 62-68). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have carried out refinishing in Mayer not after the automobile has been built but shortly after the original finishing on the production line using a fresh coating of basecoat and clearcoat since Hartung et al teaches that refinishing can be effected shortly after the original finishing on the production line using a fresh coating of basecoat and clearcoat as well as after the automobile has been built. Thus, it is irrelevant whether Hartung teaches all limitations claimed invention or not.

(C) Applicants submit that the electrostatic spray application of the original finish required by claim 1 cannot be ignored because the present invention is directed to a process, not a product-by-process. Electrostatic application of the OEM finish is clearly a positive limitation of claim 1 and, in fact, clearly a relevant part of the invention as a whole. The fact that electrostatic spraying of OEM is per se known does not negate the fact that electrostatically spraying the original finish is nowhere taught by Mayer or Hartung. (Applicants would be open to rephrasing the process limitation with respect to electrostatic spray application, if the Examiner would be receptive to acknowledging allowable subject matter.)

The Examiner respectfully disagrees with this argument. First of all, OEM finish (already) *produced* by electrostatic application is a positive limitation of claim 1 not electrostatic application step itself. Second, rephrasing the process limitation with respect to electrostatic

spray application might lead to allowable subject matter **only upon showing objective evidence of unexpected results.**

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy Lightfoot whose telephone number is 571-272-1429. The examiner can normally be reached on Monday-Friday, 9:00AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy Lightfoot, Ph.D.
Primary Examiner
Art Unit 1792

October 26, 2009

/Elena Tsoy Lightfoot/